

PATENT
674519-2001.4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Michael John Reed et al.

Serial No. : 10/084,235

For : STEROID SULPHATASE INHIBITORS

Filed : February 25, 2002

Examiner : Badio, Barbara P.

Art Unit : 1616

745 Fifth Avenue, New York, NY 10151

EXPEDITED PROCEDURE
RESPONSE AFTER FINAL ACTION
UNDER 37 C.F.R. §1.116

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TERMINAL DISCLAIMER

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Dear Sir:

This paper is being filed in response to the November 4, 2004 Office Action, which, *inter alia*, rejected claims 6-20 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Patent No. 5,616,574; claims 6-20 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Patent 6,187,766; claims 6-20 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Patent 6,642,397; claims 6-20 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Patent Application No.

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09/794,853; claims 12-16 and 19 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Patent Application No. 10/013,798; claims 6-20 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Patent Application No. 10/165,599 (now U.S. Patent No. 6,858,597); claims 6-20 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Patent Application No. 10/367,622; and, claims 6-20 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of U.S. Patent Application No. 09/572,237 (now U.S. Patent No. 6,670,353).

This Terminal Disclaimer serves to obviate the rejections of the present application and place the application in condition for allowance. A check in the amount of \$130.00 in payment of the required fee under 37 C.F.R. §1.20(d) is enclosed.

Reconsideration and withdrawal of the double patenting rejections is respectfully requested in view of this Terminal Disclaimer, the recordal of which is also respectfully requested, with any additional fee therefore or any overpayment in such fees, to be charged or credited to Deposit Account No. 50-0320.

A Terminal Disclaimer as to the '574 patent, the '766 patent, the '397 patent, the '597 patent, the '353 patent, the '853 application, the '798 application, and the '622 application is herewith provided as follows:

I, Thomas J. Kowalski, declare that I am the attorney of record and that I am authorized to execute terminal disclaimers on behalf of Sterix Limited ("Sterix"), the assignee of the above-captioned application ("the present application") and U.S. Patent No. 5,616,574 ("the '574 patent"), U.S. Patent No. 6,187,766 ("the '766 patent"), U.S. Patent No. 6,642,397 ("the '397 patent"), U.S. Patent No. 6,858,597 ("the '597 patent"), U.S. Patent No. 6,670,353 ("the '353 patent"), U.S. Application Serial No. 09/794,853 ("the '853 application"), U.S. Application Serial No. 10/013,798 ("the '798 application"), and U.S. Application Serial No. 10/367,622 ("the '622 application");

That Sterix has a place of business at Magdalen Centre, Robert Robinson Avenue, The Oxford Science Park, Oxford OX4 4GA, United Kingdom;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Patent application Serial No. 10/084,235, filed February 25, 2002 (the present application), which is a division of U.S. Application Serial No. 09/579,163, filed May 25, 2000, now U.S. Patent No. 6,642,397, which is a division of U.S. Patent Application No. 09/238,345, now U.S. Patent No. 6,187,766, by virtue of the assignments from the inventors as set out at Reel 010154 and Frame 0537, and Reel 010007 and Frame 0618, where said assignments were recorded at the U.S. Patent and Trademark Office on May 28, 1999;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Application Serial No. 07/196,192, filed December 27, 1994, now U.S. Patent No. 5,616,574 (“the ‘574 patent”), by virtue of the assignments from the inventors as set out at Reel 007008 and Frame 0281, Reel 00154 and Frame 0537, and Reel 010007 and Frame 0618, where said assignments were recorded at the U.S. Patent and Trademark Office on April 26, 1994, May 28, 1999, and May 28, 1999, respectively;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Application Serial No. 09/238,345, filed January 27, 1999, now U.S. Patent No. 6,187,766 (“the ‘766 patent”), by virtue of the assignment from the inventors as set out at Reel 010154 and Frame 0537, and Reel 010007 and Frame 0618, where said assignments were recorded at the U.S. Patent and Trademark Office on May 28, 1999;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Application Serial No. 09/579,163, filed May 25, 2000, now U.S. Patent No. 6,642,397 (“the ‘397 patent”), which is a division of U.S. Patent Application No. 09/238,345, now U.S. Patent No. 6,187,766, by virtue of the assignments from the inventors as set out at Reel 010154 and Frame 0537, and Reel 010007 and Frame 0618, where said assignments were recorded at the U.S. Patent and Trademark Office on May 28, 1999;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Application Serial No. 10/165,599, filed June 7, 2002, now U.S. Patent No. 6,858,597 (“the ‘597 patent”), by virtue of the assignment from the inventors as set out at Reel 014169 and Frame 0637, where said assignment was recorded at the U.S. Patent and Trademark Office on June 16, 2003;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Application Serial No. 09/572,237, filed December 30, 2003, now U.S. Patent No. 6,670,353

(“the ‘353 patent”), by virtue of the assignment from the inventors as set out at Reel 010817 and Frame 0789, where said assignment was recorded at the U.S. Patent and Trademark Office on May 17, 2000;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Application Serial No. 09/794,853, filed February 27, 2001 (“the ‘853 application”), which is a division of U.S. Patent Application No. 09/579,163, now U.S. Patent No. 6,642,297, which is a division of U.S. Patent Application No. 09/238,345, now U.S. Patent No. 6,187,766, by virtue of the assignments from the inventors as set out at Reel 010154 and Frame 0537, and Reel 010007 and Frame 0618, where said assignments were recorded at the U.S. Patent and Trademark Office on May 28, 1999;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Application Serial No. 10/013,798, filed December 10, 2001 (“the ‘798 application”), by virtue of the assignment from the inventors as set out at Reel 014696 and Frame 0615, where said assignment was recorded at the U.S. Patent and Trademark Office on November 17, 2003;

That Sterix is the assignee of the entire right, title and interest in, to and under U.S. Application Serial No. 10/367,622, filed February 14, 2003 (“the ‘622 application”), by virtue of the assignment from the inventors as set out at Reel 014361 and Frame 0987, where said assignment was recorded at the U.S. Patent and Trademark Office on August 8, 2003;

That the Sterix hereby disclaims the terminal part of any patent granted on the present application which would extend beyond the expiration date of the full statutory term of the ‘574 patent, the ‘766 patent, the ‘397 patent, the ‘597 patent, and the ‘353 patent, or any patent granted on the ‘853 application, the ‘798 application, and the ‘622 application;

That Sterix hereby agrees that any patent so granted on the present application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to the ‘574 patent, the ‘766 patent, the ‘397 patent, the ‘597 patent, the ‘353 patent, the ‘853 application, the ‘798 application, and the ‘622 application, this agreement to run with any patent granted on the present application and to be binding upon the grantee, its successors or assigns;

That no terminal part of any patent granted on the present application is disclaimed prior to the full statutory term of the ‘574 patent, the ‘766 patent, the ‘397 patent, the ‘597 patent, the ‘353 patent, the ‘853 application, the ‘798 application, and the ‘622 application, in the event that

the '574 patent, the '766 patent, the '397 patent, the '597 patent, the '353 patent, the '853 application, the '798 application, or the '622 application, earlier expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or is terminally disclaimed under 37 C.F.R. §1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to expiration of its full statutory term, except for the separation of legal title stated above;

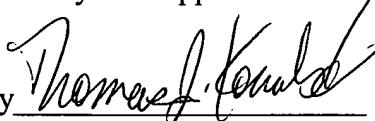
In accordance with 37 C.F.R. § 3.73(b), the undersigned attorney of record, empowered to sign this Statement on behalf of the assignee, states that Sterix, is the assignee of the entire right, title and interest in the patents and patent applications identified above (the present application, the '574 patent, the '766 patent, the '397 patent, the '597 patent, the '353 patent, the '853 application, the '798 application, and the '622 application) by virtue of the assignments identified above.

And thus, that the undersigned has reviewed documents in the chain of title of the patent and patent application identified above and, to the best of the undersigned's knowledge and belief, title is in the assignee identified above.

Reconsideration and withdrawal of the double patenting rejection, consideration and entry of this paper and recordal of this Terminal Disclaimer, and reconsideration and withdrawal of the rejection of the Final Office Action, and prompt issuance of a Notice of Allowance, are all respectfully requested; with any fee therefor or any overpayment in such fees, to be charged or credited to Deposit Account No. 50-0320.

Respectfully submitted,

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By 

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